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NOTICE OF ALLOWANCE AND FEE(S) DUE

7590

07/26/2004

Maureen Stretch
26 Charles Street
Natick, MA 01760

EXAMINER

MEINECKE DIAZ, SUSANNA M

ART UNIT

PAPER NUMBER

3623

DATE MAILED: 07/26/2004

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/702,128	10/30/2000	William J. Flanagan	ET00-008CIP	8743

TITLE OF INVENTION: SYSTEM AND METHOD FOR PROCESS MINING

APPLN. TYPE	SMALL ENTITY	ISSUE FEE	PUBLICATION FEE	TOTAL FEE(S) DUE	DATE DUE
nonprovisional	NO	\$1330	\$0	\$1330	10/26/2004

THE APPLICATION IDENTIFIED ABOVE HAS BEEN EXAMINED AND IS ALLOWED FOR ISSUANCE AS A PATENT. **PROSECUTION ON THE MERITS IS CLOSED.** THIS NOTICE OF ALLOWANCE IS NOT A GRANT OF PATENT RIGHTS. THIS APPLICATION IS SUBJECT TO WITHDRAWAL FROM ISSUE AT THE INITIATIVE OF THE OFFICE OR UPON PETITION BY THE APPLICANT. SEE 37 CFR 1.313 AND MPEP 1308.

THE ISSUE FEE AND PUBLICATION FEE (IF REQUIRED) MUST BE PAID WITHIN **THREE MONTHS** FROM THE MAILING DATE OF THIS NOTICE OR THIS APPLICATION SHALL BE REGARDED AS ABANDONED. **THIS STATUTORY PERIOD CANNOT BE EXTENDED.** SEE 35 U.S.C. 151. THE ISSUE FEE DUE INDICATED ABOVE REFLECTS A CREDIT FOR ANY PREVIOUSLY PAID ISSUE FEE APPLIED IN THIS APPLICATION. THE PTOL-85B (OR AN EQUIVALENT) MUST BE RETURNED WITHIN THIS PERIOD EVEN IF NO FEE IS DUE OR THE APPLICATION WILL BE REGARDED AS ABANDONED.

HOW TO REPLY TO THIS NOTICE:

I. Review the SMALL ENTITY status shown above.

If the SMALL ENTITY is shown as YES, verify your current SMALL ENTITY status:

- A. If the status is the same, pay the TOTAL FEE(S) DUE shown above.
- B. If the status above is to be removed, check box 5b on Part B - Fee(s) Transmittal and pay the PUBLICATION FEE (if required) and twice the amount of the ISSUE FEE shown above, or

If the SMALL ENTITY is shown as NO:

- A. Pay TOTAL FEE(S) DUE shown above, or
- B. If applicant claimed SMALL ENTITY status before, or is now claiming SMALL ENTITY status, check box 5a on Part B - Fee(s) Transmittal and pay the PUBLICATION FEE (if required) and 1/2 the ISSUE FEE shown above.

II. PART B - FEE(S) TRANSMITTAL should be completed and returned to the United States Patent and Trademark Office (USPTO) with your ISSUE FEE and PUBLICATION FEE (if required). Even if the fee(s) have already been paid, Part B - Fee(s) Transmittal should be completed and returned. If you are charging the fee(s) to your deposit account, section "4b" of Part B - Fee(s) Transmittal should be completed and an extra copy of the form should be submitted.

III. All communications regarding this application must give the application number. Please direct all communications prior to issuance to Mail Stop ISSUE FEE unless advised to the contrary.

IMPORTANT REMINDER: Utility patents issuing on applications filed on or after Dec. 12, 1980 may require payment of maintenance fees. It is patentee's responsibility to ensure timely payment of maintenance fees when due.

PART B - FEE(S) TRANSMITTAL

Complete and send this form, together with applicable fee(s), to: Mail **Mail Stop ISSUE FEE**
Commissioner for Patents
P.O. Box 1450
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INSTRUCTIONS: This form should be used for transmitting the ISSUE FEE and PUBLICATION FEE (if required). Blocks 1 through 5 should be completed where appropriate. All further correspondence including the Patent, advance orders and notification of maintenance fees will be mailed to the current correspondence address as indicated unless corrected below or directed otherwise in Block 1, by (a) specifying a new correspondence address; and/or (b) indicating a separate "FEE ADDRESS" for maintenance fee notifications.

CURRENT CORRESPONDENCE ADDRESS (Note: Use Block 1 for any change of address)

7590

07/26/2004

Maureen Stretch
 26 Charles Street
 Natick, MA 01760

Note: A certificate of mailing can only be used for domestic mailings of the Fee(s) Transmittal. This certificate cannot be used for any other accompanying papers. Each additional paper, such as an assignment or formal drawing, must have its own certificate of mailing or transmission.

Certificate of Mailing or Transmission

I hereby certify that this Fee(s) Transmittal is being deposited with the United States Postal Service with sufficient postage for first class mail in an envelope addressed to the Mail Stop ISSUE FEE address above, or being facsimile transmitted to the USPTO (703) 746-4000, on the date indicated below.

(Depositor's name)
(Signature)
(Date)

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EXAMINER	ART UNIT	CLASS-SUBCLASS
MEINECKE DIAZ, SUSANNA M	3623	705-080000

1. Change of correspondence address or indication of "Fee Address" (37 CFR 1.363).
☐ Change of correspondence address (or Change of Correspondence Address form PTO/SB/122) attached.
☐ "Fee Address" indication (or "Fee Address" Indication form PTO/SB/47; Rev 03-02 or more recent) attached. **Use of a Customer Number is required.**

2. For printing on the patent front page, list
 (1) the names of up to 3 registered patent attorneys or agents OR, alternatively, 1 _____
 (2) the name of a single firm (having as a member a registered attorney or agent) and the names of up to 2 registered patent attorneys or agents. If no name is listed, no name will be printed. 2 _____
 3 _____

3. ASSIGNEE NAME AND RESIDENCE DATA TO BE PRINTED ON THE PATENT (print or type)

PLEASE NOTE: Unless an assignee is identified below, no assignee data will appear on the patent. If an assignee is identified below, the document has been filed for recordation as set forth in 37 CFR 3.11. Completion of this form is NOT a substitute for filing an assignment.

(A) NAME OF ASSIGNEE

(B) RESIDENCE: (CITY and STATE OR COUNTRY)

Please check the appropriate assignee category or categories (will not be printed on the patent): ☐ individual ☐ corporation or other private group entity ☐ government

4a. The following fee(s) are enclosed:

- ☐ Issue Fee
☐ Publication Fee (No small entity discount permitted)
☐ Advance Order - # of Copies _____

4b. Payment of Fee(s):

- ☐ A check in the amount of the fee(s) is enclosed.
☐ Payment by credit card. Form PTO-2038 is attached.
☐ The Director is hereby authorized by charge the required fee(s), or credit any overpayment, to Deposit Account Number _____ (enclose an extra copy of this form).

5. Change in Entity Status (from status indicated above)

- ☐ a. Applicant claims SMALL ENTITY status. Sec 37 CFR 1.27. ☐ b. Applicant is not claiming SMALL ENTITY status. Sec. c.g., 37 CFR 1.27(g)(2).

The Director of the USPTO is requested to apply the Issue Fee and Publication Fee (if any) or to re-apply any previously paid issue fee to the application identified above.

NOTE: The Issue Fee and Publication Fee (if required) will not be accepted from anyone other than the applicant; a registered attorney or agent; or the assignee or other party in interest as shown by the records of the United States Patent and Trademark Office.

(Authorized Signature)

(Date)

This collection of information is required by 37 CFR 1.311. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, Virginia 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

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TRANSMIT THIS FORM WITH FEE(S)



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EXAMINER

MEINECKE DIAZ, SUSANNA M

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DATE MAILED: 07/26/2004

Determination of Patent Term Adjustment under 35 U.S.C. 154 (b) (application filed on or after May 29, 2000)

The Patent Term Adjustment to date is 365 day(s). If the issue fee is paid on the date that is three months after the mailing date of this notice and the patent issues on the Tuesday before the date that is 28 weeks (six and a half months) after the mailing date of this notice, the Patent Term Adjustment will be 365 day(s).

If a Continued Prosecution Application (CPA) was filed in the above-identified application, the filing date that determines Patent Term Adjustment is the filing date of the most recent CPA.

Applicant will be able to obtain more detailed information by accessing the Patent Application Information Retrieval (PAIR) WEB site (<http://pair.uspto.gov>).

Any questions regarding the Patent Term Extension or Adjustment determination should be directed to the Office of Patent Legal Administration at (703) 305-1383. Questions relating to issue and publication fee payments should be directed to the Customer Service Center of the Office of Patent Publication at (703) 305-8283.

Notice of Allowability

Application No.

09/702,128

Examiner

Susanna M. Diaz

Applicant(s)

FLANAGAN ET AL.

Art Unit

3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to Applicant's Responses filed June 3, 2003 and August 22, 2003.
2. ☒ The allowed claim(s) is/are 2-61.
3. ☒ The drawings filed on 30 October 2000 are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
 - * Certified copies not received: _____.
5. ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 - (a) ☐ The translation of the foreign language provisional application has been received.
6. ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application. **THIS THREE-MONTH PERIOD IS NOT EXTENDABLE**

7. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
8. ☐ CORRECTED DRAWINGS must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No. _____.
 - (b) ☐ including changes required by the proposed drawing correction filed _____, which has been approved by the Examiner.
 - (c) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No. _____.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet.

9. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|--|---|
| 1 <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 2 <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3 <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 4 <input type="checkbox"/> Interview Summary (PTO-413), Paper No. _____ |
| 5 <input checked="" type="checkbox"/> Information Disclosure Statements (PTO-1449), Paper No. <u>9,12.</u> | 6 <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 7 <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit of Biological Material | 8 <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9 <input type="checkbox"/> Other |

Susanna Diaz
Susanna Diaz
Primary Examiner
Art. 3623

EXAMINER'S AMENDMENT

1. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Maureen Stretch (Reg. No. 29,447) on August 19, 2003.

The application has been amended as follows:

Claim 2 (renumbered as claim 1 for allowance), line 4, insert executing in a

C1 processor and before "including"

 Claim 32 (renumbered as claim 31 for allowance), line 5, insert executing in a

C2 processor and before "configured"

 Claim 32 (renumbered as claim 31 for allowance), line 20, insert executing in a

C3 processor and before "configured"

Terminal Disclaimer

2. The terminal disclaimer filed on June 3, 2003 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patent Nos. 6,338,050; 6,336,105; 6,332,135; and 6,141,653 and Application Nos. 09/702,049; 09/702,128; and 09/702,062 has been reviewed and is accepted. The terminal disclaimer has been recorded.

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Allowable Subject Matter

3. Claims 2-61 are allowed.

4. The following is an examiner's statement of reasons for allowance:

The present invention has been deemed allowable for its unique manner of conducting negotiations between human users, including **"the analysis of terms comprising understanding the purpose of the terms, formatting the terms according to the purpose, and placing them into user supplied context"** and the "automated negotiations engine further recognizing any changes in the terms and storing in the storage space the terms each terminal proposes, and recognizing the terminal to which the proposed terms are being sent as the indicated terminal, and sending terms to the indicated terminal, **the automated negotiations engine indicating any changes in the terms** until a set of terms is acted upon in a final manner" (variations of these limitations are recited throughout independent claims 2, 17, 32, and 47). The limitation **"the analysis of terms comprising understanding the purpose of the terms, formatting the terms according to the purpose"** has been interpreted to reflect the fact that when a user changes one of the negotiation terms, the negotiations engine does not just merely forward redline corrections, but it processes the change to decide to which category of terms the change correlates. This assertion is supported by Applicant's arguments found on pages 2-4 of Applicant's Response filed August 22, 2003. Furthermore, the recited term "analysis" is defined as the "separation of a whole into its component parts" (Merriam-Webster's Collegiate® Dictionary (10th

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Ed.)). Furthermore, "context" is defined as "the parts of a discourse that surround a word or passage and can throw light on its meaning." (Please see attachment to the present Office action.) Therefore, Applicant's intended interpretation of "analysis" and "context," as set forth in both the specification and Applicant's Response filed August 22, 2003, are clearly in line with the accepted definitions of each word. As such, the claimed invention recites a more intelligent negotiations engine that performs an analysis of negotiation terms that goes beyond mere redlining.

Silverman et al. (U.S. Patent No. 5,924,082) teach an interactive negotiations system between at least two human users, where the users may communicate with one another through a structured dialog; however, they fail to anticipate or suggest a negotiations engine which itself can identify the types of changes being made. Silverman et al. maintain a transcript of the negotiations session, but its central computer system does not analyze the changes to classify them by their particular term categories.

Furthermore, regarding the limitation **"the automated negotiations engine indicating any changes in the terms,"** the Shirley et al. reference (U.S. Patent No. 5,692,206) has been cited to teach a contract generation system which allows for manual editing (e.g., redlining) of the document for customization purposes (Abstract). Unlike the Shirley et al. reference, the present invention obviates the need for manual editing, which can cause a messy presentation and be time-consuming, by implementing a negotiations engine which itself handles the recognition and indication of changes in terms to the negotiating parties.

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Ordish (U.S. Patent No. 5,195,031) teaches a trading system for providing real time context sensitive trading messages based on conversation analysis; however, Ordish's invention only provides relevant prompts and alerts in response to inconsistencies in the trading conversation. Ordish does not disclose or suggest the claimed document recompilation based on the most updated terms of the contract being negotiated, including the analysis of terms which are then placed into a user supplied context.

The presently claimed invention is also deemed novel over Sloo (WO 97/04410) because Sloo merely performs a redlined mark-up of the submitted document changes. Sloo does not disclose or suggest the claimed automated document recompilation based on the most updated terms of the contract being negotiated, including the analysis of terms which are then placed into a user supplied context.

Similarly, the TRADE'ex software (disclosed in the articles "TRADE'ex Unveils Marketmaker Software for Creating Online Marketplace," "TradeAccess Sponsors First U.S. Trade Mission Web Site for Department of Commerce," "Trade'ex Readies Java-based MarketMaker," "TRADE'ex Connects the UK," "TRADE'ex Introduces E-Commerce Software for Procurement, Distribution, Virtual E-Markets," "10 Who Dared to Be Different," "Pioneering Reseller Sites," and "TRADE'ex Develops Java Compliant Electronic Commerce Solution for Creating Wholesale Markets Over the Internet") does not disclose or suggest the claimed automated document recompilation based on the most updated terms of the contract being negotiated, including the analysis of terms which are then placed into a user supplied context.

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Additionally, Applicant explains in the Response filed August 22, 2003 that Kennedy (U.S. Patent No. 6,055,519) simply stores data regarding a negotiation; however, no analysis (as defined by the Applicant) of the negotiation terms is performed.

Snelgrove et al. (US 2002/0058532) teaches the use of software agents to perform negotiations among themselves (§§ 56, 76, 78, 90); however, Snelgrove is silent as to whether the software agents analyze the negotiation terms *per se* or just perform mere redlining; therefore, Snelgrove too is deficient in the teaching of the analysis of negotiation terms and placing them into a user supplied context for presentation to a user.

Smiga et al. (U.S. Patent No. 6,029,171) teaches a method of parsing messages for purposes of collaborating among users. For example, Smiga can parse messages and identify related activities (col. 7, lines 14-20; col. 9, line 1 through col. 10, line 25). In another embodiment Smiga parses messages to negotiate a meeting date (Fig. 25B; col. 34, lines 27-58); however, Smiga's system merely presents a date change to the users while the negotiation participants are the ones who make a final decision regarding the date change. In other words, there is no analysis of negotiation terms and placing them into a user supplied context for presentation to a user, as defined by the Applicant.

Please note that all of the pending claims in the present case are indicated as allowable subject matter for the same reasons found throughout the parent applications (U.S. Patent Nos. 6,338,050; 6,336,105; 6,332,135; and 6,141,653).

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Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (703) 305-1337. The examiner can normally be reached on Monday-Friday, 9 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (703) 305-9643.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 308-1113.

Any response to this action should be mailed to:

**Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450**

or faxed to:

(703) 305-7687 [Official communications; including
After Final communications labeled
"Box AF"]

(703)746-7048 [Informal/Draft communications, labeled
"PROPOSED" or "DRAFT"]

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Application/Control Number: 09/702,128

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Art Unit: 3623

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 22202, 7th floor receptionist.

Susanna Diaz
Susanna M. Diaz
Primary Examiner
Art Unit 3623
August 22, 2003

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